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|--|-------------|----------------------|-------------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/608,384 | 06/27/2003 | Jeffrey W. Carr | CARR-01000us4.002 | 7970 |
| 7590 | 12/15/2005 | | EXAMINER | |
| Sheldon R. Meyer FLIESLER DUBB MEYER & LOVEJOY LLP Fourth Floor Four Embarcadero Center San Francisco, CA 94111-4156 | | | VINH, LAN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1765 | |
| | | | DATE MAILED: 12/15/2005 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 10/608,384 | CARR, JEFFREY W. |
| | Examiner Lan Vinh | Art Unit 1765 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 November 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-40 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action in view of the newly amended claims 1-39 is persuasive and, therefore, the finality of that action is withdrawn. However, upon further consideration and search, a new ground of rejection is made in view of Carr (US 2004/0173316A1)

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16, 18-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29-71 of copending Application No. 10/383,478. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 29-71 of co-pending

Application 10/383,478 discloses/requires a narrower limitation (a microwave-induced plasma torch), which encompasses the broader limitation (a plasma torch), as required by claims 1-16,18-40 in the instant claimed invention. Since the narrower claims 29-71 of copending Application 10/383,478 reads on the broader claims of the instant claimed invention, the present claimed inventions and claims 29-71 of copending Application 10/383,478 are not patentably distinct. The following table compares the claims between US 2004/0173316 A1 and the present claimed inventions

| Present invention claims | US 2004/0173316 |
|--------------------------|-----------------|
| 1-3, 21, 36, 37, 40 | 29-32, 58, 59 |
| 4-9 | 33-37 |
| 10-16 | 38-44 |
| 18-20 | 54-56 |
| 22-26 | 46-49 |
| 27-31 | 59-61 |
| 32-35 | 63-65 |
| 38 | 69 |
| 39 | 71 |

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 17 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 29 of copending Application No.

10/383478 in view of Fleming ((US 5,000,771). Claim 29 of copending Application

10/383,478 meets all the limitations of the instant claimed invention as per claim 17
except maintaining the temperature of the plasma between 5000-15,000 degree C

Fleming discloses maintaining the temperature of the plasma torch at greater than 9000⁰ C (see abstract). One skilled in the art at the time the invention was made would have found it obvious to modify claim 29 of Application 10/383,478 by maintaining the temperature of the plasma at 9000 degree C (between 5000-15,000 degree C) as per Fleming because Fleming discloses that the surface material is substantially removed by vaporization due to the extremely high plasma temperature (>9000 degree C) (see abstract)

This is a provisional obviousness-type double patenting rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Vinh whose telephone number is 571 272 1471. The examiner can normally be reached on M-F 8:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571 272 1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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December 6, 2005